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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,978	12/11/2006	James W. Halbrook	N0260.70068US01	1639
23628 7590 05/28/2010 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER ANDERSON, REBECCA L				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
05/28/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,978

Applicant(s)

HALBROOK ET AL.

Examiner

REBECCA L. ANDERSON

Art Unit

1626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 1, 9 and 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

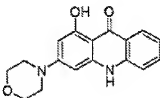
- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 9 and 22-24 are currently pending in the instant application. Claims 1, 23 and 24 are rejected. Claims 1, 9 and 22-24 are objected.

Election/Restrictions

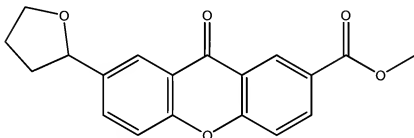
Applicant's election of Group I and the further election of the species:



in the reply filed on 18 September 2009 has been acknowledged and the elected species appears allowable over the prior art of record.

Applicants' amendment filed 9 March 2010 has overcome the 35 USC 112 2nd paragraph rejection of claims 1, 23 and 24. As applicant has deleted carboxyl from the variable R1 in the claims, the 35 USC 102(b) rejection as being anticipated by the species 7-(2-tetrahydrofuryl)-xanthone-2-carboxylic acid is overcome.

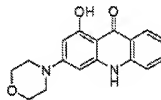
Therefore, according to MPEP 803.02, the search and examination has been extended to the non-elected species of



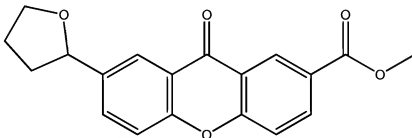
methyl 7-(2-tetrahydrofuryl)-xanthone-2-carboxylate

As this non-elected species has been found not allowable, the Markush-type claims have been rejected and claims to the non-elected invention held withdrawn from further consideration.

Claims 1, 9 and 22-24 have been examined to the extent that they are readable



on the elected embodiment, the elected species of



and the species

methyl 7-(2-tetrahydrofuryl)-xanthone-2-carboxylate

. Since the

non-elected species was found not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration.

It has been determined that the entire scope of claimed is not patentable.

As a non-elected species has been rejected under 35 USC 102(b), the claim objection is maintained.

Maintained Claim Objections

Claims 1, 9 and 22-24 are objected to as containing non-elected subject matter. Claims 1, 9 and 22-24 presented drawn solely to the elected embodiment would overcome this objection or an amendment to overcome the pending rejections in the instant application would overcome this objection as the search and examination of the claims according to MPEP 803.02 would continue.

New Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

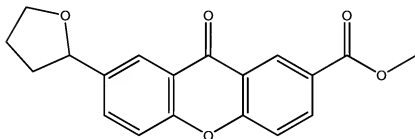
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,835,158.

US Patent No. 3,835,158 discloses compounds of the formula (A) useful for the treatment of symptoms associated with allergic manifestations, such as asthmatic conditions (column 1, lines 5-20). Column 2, lines 40-50 disclose pharmaceutical compositions, including combinations with other compounds such as antibiotics. An

example of a compound of the formula (A) is found in example 9:



methyl 7-(2-tetrahydrofuryl)-xanthone-2-carboxylate , column 21 which

corresponds to applicants' claimed invention wherein A is a 5 membered aliphatic ring containing 1 heteroatom of oxygen; n is 0; each Z is CR_b wherein R_b is hydrogen; X is O; m is 1; and R₁ is carboxy which is defined on page 18 of the instant specification to be COOR_d and R_d in claim 1 can be alkyl, i.e. methyl. The antibiotic of column 2 corresponds to the antineoplastic agent required in claim 24, see page 27 of the instant specification wherein antibiotics are listed in chemotherapeutic agents.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
Technology Center 1600

26 May 2010

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Art Unit: 1626

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